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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,793	02/25/2004	Craig A. Bonda	27702/10059	3775
4743	7590	08/30/2007		
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER SACKEY, EBENEZER O	
			ART UNIT	PAPER NUMBER
			1624	
			MAIL DATE	DELIVERY MODE
			08/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,793

Applicant(s)

BONDA ET AL.

Examiner

EBENEZER SACKY

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-88 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All. b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 11-15 are, drawn to compounds of formula (I) and compositions containing formula (I), classified in class 514 and 558, in various subclasses.
- II. Claims 5-6 are, drawn to compounds of structural formula (II), classified in class 558, subclass 388+.
- III. Claim 7-10 are, drawn to a reaction product, classified in class 558, in various subclasses.
- IV. Claims 16-19 are, drawn to a method of protecting human skin from ultraviolet radiation employing compounds of formula (I), classified in class 424, subclass 70+.
- V. Claims 20-25 are, drawn to a method of water proofing a surface and selected area, with compounds of formula (I), classified in class 427, in various subclasses.
- VI. Claims 26-28 are, drawn to method of forming a film over a surface using compounds of formula (I), classified in class 399, in various subclasses.
- VII. Claims 29-32 are, drawn to a method of photo stabilizing a dibenzoylmethane derivative by using compounds of formula (I), classified in class 585, in various subclasses.

- VIII. Claims 33-36 and 39-43 are, drawn to compounds of formula (VI) and compositions containing formula (VI), classified in class 514 and 558, subclass 590 and 388+.
- IX. Claims 37-38 are, drawn to compounds of formula (VII), classified in class 558, subclass 388+.
- X. Claims 44-47 are, drawn to a method of protecting human skin from ultraviolet radiation, classified in class 424, subclass 59+.
- XI. Claims 48-50 are, drawn to a method of water proofing a surface using compounds of formula (VI), classified in class 427, in various subclasses.
- XII. Claims 51-53 are, drawn to a method of protecting a selected surface using compounds of formula (VII), classified in class 134, in various subclasses.
- XIII. Claims 54-56 are, drawn to a method of forming a film over a surface using compounds of formula (VI), classified in class 399, in various subclasses.
- XIV. Claims 57-60 are, drawn to a method of photo stabilizing a dibenzoylmethane derivative using compounds of formula (VI), classified in class 585, in various subclasses.
- XV. Claims 61-64 and 67-71 are, drawn to compounds of formula (IX) and compositions containing formula (IX), classified in class 514 and 558, in various subclasses.

- XVI. Claims 65-66 are, drawn to compounds of formula (X), classified in class 558, subclass 303+.
- XVII. Claims 72-75 are, drawn to a method of protecting human skin from ultraviolet radiation using composition of claim 67, classified in class 514, subclass 123+.
- XVIII. Claims 76-84 are, drawn to a method of water proofing a selected surface, protecting a selected surface, forming a film over a surface with compounds of formula (IX), classified in class 558, subclass 236+.
- XIX. Claims, drawn to a method of photo stabilizing a dibenzoylmethane derivative with compounds of formula (IX) classified in class 585, in various subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I-II, VIII-IX, XV-XVI and IV-VII, X-XIV, XVII-XIX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method as claimed can be practiced with a materially different compound such as shown in U.S. Patent number 5,993,789.

Inventions I-II, VIII-IX, XV-XVI and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially

different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as shown in U.S. Patent number 5,576,354. Additionally, IV-VII, X-XIV, XVII-XIX are drawn to distinct methods of using the various compounds and compositions of the invention such as shown in the specification for coating and protecting various surfaces and thus, the literature search for each of the various Groups will not be the same and hence, a reference anticipating one member will not necessarily render the other obvious.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Richard Anderson on 08/25/07 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is

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(571) 272-1600.

EOS

August 28, 2007


for James O. Wilson
Supervisory Patent Examiner
Art Unit 1624, Group 1600
Technology Center 1